

REMARKS/ARGUMENTS

Claims 1-16 are pending in the application. Claims 1-4, 6, 9, and 12 are withdrawn from consideration, in view of a Restriction Requirement. Claims 4 and 5 have been amended. Claims 13-16 are added. Claims 4 and 5 were amended for minor editorial purposes and to edit their dependencies, and not to limit their scope.

Support for the amendments to claims 4 and 5 and new claims 17-21 can be found in the claims and specification, as originally filed, e.g., at page 5, lines 20 to 28 and page 6, lines 26 to 35. No new matter has been added.

Reconsideration of the claimed invention is requested in view of the following remarks.

Rejections under 35 U.S.C. § 102 & 103

The rejection of claims 5, 7 and 10-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Henn et al. (US Patent No. 5,525,637), the rejection of claim 8 under 35 U.S.C. § 103(a) as obvious over Henn et al. are respectfully traversed.

As the Office is aware, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

In the present case, the identical aqueous dispersion in amended claim 1 has not been shown or proven in complete detail in Nakata, since the claimed dispersion presently comprises:

A process for preparing expandable, pelletized thermoplastic polymer materials comprising, *inter alia*,

*preparing a **mixture** from 50 to 90% by weight of **polystyrene B** selected from free-radical-polymerized glass-clear polystyrene (GPPS) or anionically polymerized polystyrene (APS), **and** from 10 to 50% by weight of **styrene copolymer A** selected from styrene-butadiene block copolymer, styrene- α -methylstyrene copolymer, acrylonitrile-butadiene-styrene (ABS), styrene-acrylonitrile (SAN), acrylonitrile-styrene-acrylate (ASA), methacrylate-butadiene-styrene (MBS), or methyl methacrylate-acrylonitrile-butadiene-styrene (MABS) polymers.*

By contrast, Henn et al. describes a different composition, i.e., styrene polymers for elastic polystyrene foams, comprising, *inter alia*,

a) from 50 to 90% by weight of polystyrene and/or a styrene copolymer containing at least 50% by weight of copolymerized styrene,

b) from 5 to 30% by weight of at least one styrene-soluble elastomer, and

c) from 5 to 20% by weight of at least one block copolymer containing styrene as one component.

(See col. 1, lines 6 to 49 and col. 3, line 62 to col. 4, line 12).

Applicant notes the Office's reference to column 3, lines 35-41 of the Henn et al. (See Office Action at page 3, para. 6) as a description of the claimed mixture. However, Applicants point out that the mixture is only component a) of the styrene polymers, in which components b) and c) are also necessary components. As such, for at least this reason, the thermoplastic polymer material produced by the claimed invention is entirely different from the polystyrene foams described in Henn et al.

Applicant further notes the Office's assertion at page 3, para. 4 of the Office Action that the present claims are merely product-by-process claims, in which patentability is based only on the product itself (citing *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985) (internal citations omitted)). However, Applicant points out, as discussed *supra*, that the product resulting product is different from the disclosure of Henn et al. Moreover, regarding product-by-process claims, in *Abbott Laboratories v. Sandoz Inc.*, ___ F.3d ___ (Fed. Cir. 2009)(Rader, J.)(partially *en banc*)(citations omitted), the Federal Circuit recently overruled the prior precedent of *Scripps Clinic & Research Foundation v. Genentech, Inc.* 927 F.2d 1565 (Fed. Cir. 1991)(Newman, J.), and determined that “[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention” (quoting *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 19 (1997)).

However, in the present case, when each element of the expandable, pelletized thermoplastic polymer materials is considered, the claimed invention, including claim 8, is novel and unobvious over Henn et al. Accordingly, reconsideration and withdrawal of the rejection is requested.

Applicants further submit that new claims 13-16, dependent directly or indirectly from claim 5, are novel and unobvious over the cited references of record.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution, the undersigned is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00266-US1 from which the undersigned is authorized to draw.

Dated: August 27, 2009

Respectfully submitted,

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